

REMARKS

By the above amendment, the title has been amended to be more clearly indicative of the claimed invention, claim 1 and the dependent claims under consideration have been amended and new claims 14 - 22 have been presented. Also, the abstract has been amended to overcome the points noted by the Examiner.

With respect to the Examiner withdrawing claims 2 and 6 - 13 from consideration, it is noted that the Examiner in paragraph 2 at page 2 of the office action states "Election was made without traverse in the reply filed 7/20/05". Applicants submit that the Examiner has mischaracterized the response, which provided in the first full paragraph at page 3 of the response, "applicants provisionally elect with traverse the Species identified by the Examiner as Species I ... and submit that at least claim 1 which is a generic claim, and claims 3 - 5 are readable on the election Species I, which has been elected with traverse". Thus, it is apparent that applicants made the election with traverse contrary to the Examiner's indication. Furthermore, with respect to the Examiner's withdrawal of claims 3 and 4, since claim 3 depends upon claim 2 which is non-elected, and claim 4 depends upon claim 3, by the present amendment, claims 3 and 4, as amended, depend upon claim 1, and should be considered. Furthermore, by the present amendment, new claims 14 - 22 have been presented which recite the features of Species II, and upon allowance of claim 1 should be considered therewith.

As to the objection to claims 1 - 5 because of the informalities noted, applicants submit that claims 1 and 5 have been amended in a manner which is responsive to the informalities noted by the Examiner, such that applicants submit that the objections to claims 1 - 5 should now be overcome.

Applicants note that by the present amendment, claim 1, in addition to being amended to overcome the informalities noted by the Examiner, has been amended to further recite the feature of the exposure device as "comprising an LED array arranged in a widthwise direction of an associated photosensitive drum" which feature is described in the paragraph bridging pages 22 and 23 of the specification. In this regard, it is noted that newly presented dependent claim 14 recites the feature that the LED array comprises 600 to 1200 LEDs per 1 inch, as described at page 23, lines 5 - 8 of the specification, for example. Furthermore, it is noted that claim 1 has also been amended to clarify the structural arrangement of the plurality of image forming devices with respect to a straight portion of an endless intermediate transfer belt. That is, claim 1 now recites the feature that the image forming devices are arranged vertically along the straight portion of the endless intermediate belt, as illustrated in Fig. 1 of the drawings of this application, for example, whereby each photosensitive drum is in contact with an outer peripheral surface of the straight portion. Applicants, submit that the aforementioned features of claim 1 and the dependent claims are not disclosed or taught in the cited art, as will become clear from the following.

The rejection of claim 1 under 35 USC 102(b) as being anticipated by Numazu et al (US 5,765,082) and the rejection of claim 5 under 35 USC 103(a) as being unpatentable over Numazu et al (US 5,765,082) in view of Nishimura et al (US 5,475,478); such rejections are traversed insofar as they are applicable to the present claims and reconsideration and withdrawal of the rejections are respectfully requested.

As to the requirements to support a rejection under 35 USC 102, reference is made to the decision of In re Robertson, 49 USPQ 2d 1949 (Fed. Cir. 1999), wherein

the court pointed out that anticipation under 35 U.S.C. §102 requires that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the court, if the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if the element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Moreover, the court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

As to the requirements to support a rejection under 35 USC 103, reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under '103 to establish a prima facie case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Furthermore, such requirements have been clarified in the decision of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002) wherein the court in reversing an obviousness rejection indicated that deficiencies of the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge".

The court pointed out:

The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion. (emphasis added)

Irrespective of the contentions by the Examiner concerning the disclosure of Numazu et al, applicants note that this patent does not disclose or teach the now recited feature of "each exposure device comprising an LED array arranged in a widthwise direction of an associated photosensitive drum." (emphasis added). More particularly, as shown in Fig. 4 of Numazu et al, there are provided exposure heads 109 as described in column 15, of Numazu et al such that not only does this patent fail to disclose an LED array, this patent also fails to disclose that such array is arranged in a widthwise direction of an associated photosensitive drum, as recited in claim 1. Additionally, in accordance with the present invention, as now recited in claim 1, the image forming devices are arranged vertically along a straight portion of an endless intermediate transfer belt, as shown in Fig. 1 of the drawings of this

application, for example. In contradistinction, as shown in Figs. 3 and 4 of Numazu et al, the image forming devices are arranged horizontally along a straight portion of an endless intermediate transfer belt. Thus, applicants submit that claim 1 as amended, patentably distinguishes over Numazu et al in the sense of 35 USC 102 and 35 USC 103 such that claim 1 and the dependent claims should be considered to be allowable thereover.

As to the combination of Numazu et al and Nishimura et al, irrespective of the utilization of Nishimura et al concerning detachable mounting, this patent does not overcome the deficiencies of Numazu et al as pointed out above. That is, applicants submit that Nishimura et al does not disclose an exposure device arranged in the manner defined, which exposure device comprises a LED array arranged in a widthwise direction of an associated photosensitive drum, and Nishimura et al also does not disclose a plurality of image forming devices arranged vertically along the straight portion of an endless intermediate transfer belt, and the other features of claim 1 and the dependent claims thereof. Accordingly, applicants submit that claim 1 and the dependent claims also patentably distinguish over Numazu et al and Nishimura et al taken alone or in combination in the sense of 35 USC 103 such that claim 1 and the dependent claims should be considered allowable thereover.

With respect to other dependent claims, applicants submit that claims 3 and 4 have been amended to properly depend from claim 1 and should be considered at this time and recite features not disclosed or taught in the cited art. Additionally, claim 2, although withdrawn from consideration, depends from claim 1 and should be considered therewith and deemed to be allowable. Likewise, new dependent claims 14 - 22 which depend directly or indirectly from claim 1 should also be considered at this time and found allowable. Additionally, since dependent claims 15 - 22

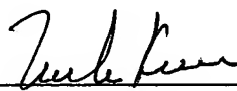
correspond to features found in claims 6 - 13, applicants submit that such claims should also be considered at this time and also deemed to be allowable.

In view of the above amendments and remarks, applicants submit that all claims present in this application should now be in condition for allowance and issuance of an action of favorable nature is courteously solicited.

To the extent necessary, applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case: 500.43230X00), and please credit any excess fees to such deposit account.

Respectfully submitted,

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